

### **REMARKS**

Reconsideration and allowance are requested. In this RCE, claims 32, 36, 37, 38, 43, 48, 53 and 54 are amended. The Abstract is also amended per the Examiner's previous request.

In addition to the previous arguments regarding the patentability of the claims under Sections 102 and 103, Applicant hereby presents further arguments in view of the Advisory Action.

#### **Rejection of Claims 32 – 35 and 38 – 42 Under Section 102**

The Advisory Action does not mention Applicant's arguments regarding the patentability of claims 32 – 35 and 38 – 42 under Section 102(b) over Gilhousen et al. Accordingly, Applicant submits that these claims are patentable over the reference based on the previous arguments presented which set forth in detail the features not taught by Gilhousen et al.

#### **Rejection of Claim 36 Under Section 102**

Applicant reasserts that Erving fails to teach each limitation of claim 36. In the Advisory Action, the Examiner did not give the limitation related to a terrestrial wireless network patentable weight. Accordingly, the independent claims are amended to recite that the steps occur at an access port of a terrestrial wireless network. Accordingly, Applicant submits that Erving does not teach each limitation of the claims including claim 36.

#### **Rejection of Claims 37 and 43 – 48, 53 - 56 Under Section 103**

The Advisory Action also responds to Applicants Section 103 arguments on pages 13 – 15 of the previous response by arguing that “the references clearly discloses the claimed invention and the motivation would has [sic] been for integrate [sic] the wireless and wireline [sic] network in order to expand the wireless network.” Applicant notes that the Final Office

Action stated a different motivation, which was to combine the references in order to “improve the throughput of the wireless system.” FOA, page 5.

The Advisory Action apparently concedes or accepts Applicant’s argument in response to the final office action that “improved throughput” is a non-existent or insufficient motivation to combine these references. Applicant previously argued that there was insufficient motivation to combine Natali et al. with Focarile et al. Thus in response to Applicant’s arguments the Advisory Action asserts that the motivation is to expand the wireless network. However, Natali et al. disclose a power efficient paging invention for mobile users. The goal in that reference is to keep the overhead in the paging channel to a minimum. Col. 1, lines 35 – 37. The advantage of Natali et al. does not provide the benefit of the motivation to combine articulated by the Advisory Action – namely to “expand” the wireless network. Accordingly, Applicant requests the Examiner to reconsider the analysis in that the benefit of “expanding” the wireless network is not met when the references are combined.

Next, the Advisory Action responds to the Applicant’s arguments on page 15 regarding the combination of Mettiffin, Natali et al. Focarile et al. and Gilhousen et al. The Advisory Action states “the references disclose the claimed invention and motivation to intergate [sic] the teachings of the references into each other.” Applicant respectfully notes that this statement does not provide any detail regarding a motivation/suggestion position inasmuch as it is merely a general statement that motivation exists to integrate the teachings of the references into each other. Therefore, there is no real response to Applicant’s arguments.

However, Applicant provides in this RCE yet further reasons that Gilhousen et al. cannot be combined with Focarile et al. Notably, Focarile et al. state that their system’s purpose is to solve the problem in the art that there is “no system which can directly transport cellular radio data to their destination, whether the destination is the PSTN or another cellular

system, without adding additional hardware to the switch or adding multiple levels of translation of the data. A further problem I the art is that there is no system to transport 8kbps packets to a point close to the final destination before converting them into 64 kbps packets.” Col. 3, lines 37 – 44. In other words, as data travels through the network at the standard 64 kbps rate it causes problems. Therefore, the solution suggested by Focaril et al. is:

Further, this invention provides for reduced operating cost by allowing the 8 Kbps compressed voice packets to be transmitted through the entire network and only converted to 64 Kbps at a switch close to the final destination, when that destination is a land based line. When the final destination is another mobile unit, no conversion the 64 Kbps is ever required. This improves the voice quality for mobile-to-mobile communication. Col. 4, lines 1 – 8.

Given these details about the problems in the prior art identified by Focarile et al., we turn to Gilhousen et al. to study their disclosure and suggestive power. FIG. 8 of Gihousen et al. teach the basic mobile telephone switching office (MTSO) equipment. In this case, they disclose switches 302, a diversity combiner 304, a digital switch 308, a vocoder 306 and communication with a PSTN. Gilhousen et al. teach that the vocoder 306 converts the format of the digitized voice signal to “standard” 64 kbps PCM telephone format or other standard format. The resultant signal is transmitted from vocoder 306 to digital switch 308 and to the PSTN. See, Col. 26, lines 11 – 16. Thus we can see that Gilhousen et al. teach the standard 64 kbps transmission format that is criticized by Focarile et al. Were these references to be combined, then Gihousen et al. would have to change its transmission of signals through the system from what they expressly teach as a standard process to a non-standard process as proposed by Focarile et al. Where such as change is required for the blending of two references, there cannot be motivation or suggestion to combine. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to

render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

In addition to the change in operation of the teachings of Gilhousen et al., Applicant again notes that Focarile et al. expressly criticize the MTSO taught in Gilhousen et al. (See further, Focarile et al. col. 3, lines 3 – 45 wherein they identify the problems with the 64 kbps MTSO of Gilhousen et al.). Therefore, because of these numerous issues with the combination of these references, Applicant submits that the evidence against the combination continues to mount and is easily beyond a preponderance of the evidence. Accordingly, claims 53 and 55 are patentable over the combination of cited art.

The additional arguments above identifying Focarile et al.'s express teachings away from Gilhousen et al. are also applicable to the rejection of claims 54 and 56 which Applicant discussed on page 16 of the response to the Final Office Action. The Examiner asserts that the motivation to combine is to expand the wireless network but both that issue as well as the combination of Gilhousen et al. and Focarile et al. have been addressed in the previous response and herein. There are simply too many issues that arise to maintain an obviousness rejection based on the combination of these many references.

### **CONCLUSION**

Applicant respectfully submits that given the previous arguments and additional argument in this RCE that the present application is in condition for allowance. Applicant requests a notice to that effect.

Respectfully submitted,

Date: June 15, 2006

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